

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OSAMU KOIZUMI

Appeal No. 2000-0558
Application No. 08/912,585

HEARD: JANUARY 24, 2001

Before STAAB, McQUADE, and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 3 and 7 through 9, which are all of the claims pending in this application.¹

¹ Finally rejected claims 1, 5 and 6 were canceled via applicant's amendments filed January 29, 1999 (Paper No. 11) and April 1, 1999 (Paper No. 15), entry of which was approved as indicated by the examiner in the advisory actions mailed February 9, 1999 (Paper No. 13) and April 12, 1999 (Paper No. 16). Claim 9 was added to replace claim 6 in Paper No. 11 and was further amended in Paper No. 15.

We affirm-in-part.

BACKGROUND

The appellant's invention relates to a data cartridge (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

THE REJECTION ²

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hakanson et al. (Hakanson) 4,570,197 Feb. 11, 1986

The prior art discussion on pages 1 through 5 of the appellant's specification (applicant's admitted prior art)

Claims 2, 3 and 7 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over applicant's admitted prior art in view of Hakanson.

² The final rejection of claim 8 under 35 U.S.C. § 102(b) is indicated as deleted by the examiner (answer, page 4). The appellant acknowledges that the § 102 rejection of claim 8 is deleted (reply brief, page 5) and that claim 8 is included in the § 103 rejection (reply brief, page 6). Accordingly we consider the rejection of claim 8 as being only under 35 U.S.C. § 103.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 18, mailed June 3, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 17, filed April 22, 1999) and reply brief (Paper No. 21, filed July 27, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

--the obviousness rejection of claims 2, 3, 7 and 9--

We reverse the rejection of claims 2, 3, 7 and 9 under 35 U.S.C. § 103 as being unpatentable over applicant's admitted prior art in view of Hakanson.

Claim 2 is directed to a cartridge having an aluminum base plate, a magnetic tape loaded in the cartridge, and a feeding mechanism mounted on the base plate for feeding the magnetic tape across a magnetic head, the improvement comprising an electrically conductive film on each surface of the aluminum base plate wherein the electrically conductive film is formed by chromate treatment.

Hakanson discloses (column 1, lines 32-41)

an improved method of reducing electrostatic charge buildup in cassettes which house magnetic recording tape by the application of non-volatile, electrically conductive, organic coating compositions to surfaces of the cassettes and the components of the cassette. The coating composition is preferably applied to all surfaces which do not directly contact the magnetic recording tape during storage or playback mode, although those surfaces may also be coated.

It is the examiner's opinion that the admitted prior art discloses that the claimed type of cartridge with a metallic base plate is known and that it would have been obvious to a person having ordinary skill in the art to provide the prior art cassette with a conductive coating as taught by Hakanson

to reduce electrostatic buildup (final rejection, page 2) and to use chromate treatment (which is well known) to form the conductive film/coating of Hakanson (answer, page 4).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. See In re Fine, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

The appellant argues that Hakanson teaches only "electrically conductive organic coatings"... a coating of organic material is not formed by chromate treatment of aluminum as recited in claim 2 (reply brief, page 2).

We note that Hakanson teaches that "[t]he organic coating composition useful in the practice of the present invention may be any non-volatile, non-integral, organic, electrically conductive composition" (column 3, lines 13-16).

We do not find any evidence of a teaching or suggestion in Hakanson (or in applicant's admitted prior art) to use a chromate treatment to provide a coating as required by claim 2. We note the examiner's contention that chromate treatment/coating of metals is well known (answer, page 4), however without some teaching or suggestion in the prior art to use chromate treatment in Hakanson's process we must conclude that the examiner's argument that it would have been obvious to use chromate treatment in Hakanson's process relies on impermissible hindsight.³ Hence, it is our opinion that the combined teachings of applicant's admitted prior art and Hakanson do not teach or suggest using chromate treatment and

³ Rejections based on ' 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

thus would not yield the subject matter recited in claim 2 on appeal.

Accordingly, for the above reasons, the examiner's rejection under 35 U.S.C. § 103 of claim 2, and of dependent claims 3, 7 and 9, will not be sustained.

--Claim 8--

We affirm the rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over applicant's admitted prior art in view of Hakanson.

Claim 8 requires that the electrically conductive film is coated on the base plate and is connected to an electrical ground integral with the feeding mechanism.

It is the examiner's position that it would have been obvious to a person having ordinary skill in the art to provide the prior art cassette with a conductive coating as taught by Hakanson to reduce electrostatic buildup (answer, pages 3 and 4).

The appellant's only argument is that the examiner has failed to indicate how or where the prior art of record teaches the connection between the electrically conductive film and ground which is integral with a feeding mechanism as recited in claim 8 (reply brief, page 6). The appellant does not dispute that the data cartridge, base plate, magnetic tape and feeding mechanism are part of the applicant's admitted prior art, indeed claim 8 is in Jepson format with these features in the preamble. We note that the term "integral", as used in the context of applicant's specification, would be interpreted by one of ordinary skill to mean electrically connected.⁴ This is consistent with appellant's statement that the electrical path from the conductive film on the base plate to ground is provided by, or integral with, the feeding mechanism (brief, page 4).

⁴ It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in
(continued...)

⁴(...continued)
light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Accordingly, the issue before us is whether coating of the admitted prior art data cartridge by the method of Hakanson would result in an electrically conductive film coated on each surface of the base plate and connected to an electrical ground integral with the feeding mechanism thereby reducing electrostatic charge buildup.

As disclosed by Hakanson, the purpose of coating the components of the cassette is for reducing the electrostatic charge buildup which, to one of ordinary skill in the art, would mean that the coating is electrically connected to, or integral with, ground. Hakanson also discloses that the coating is applied to all surfaces, and specifically that "both interior and exterior surfaces of the cassette, reels, spools, structural supports, and other parts of the cassette should be coated" (column 2, lines 50-53). Thus, both sides of the base plate as well as the feeding mechanism would be coated and the coating would be connected to, or integral with, ground.

Thus, it is our opinion that the combined teachings of applicant's admitted prior art and Hakanson fairly teaches or suggests a data cartridge comprising a metallic base plate having an electrically conductive film connected to an electrical ground integral with the feeding mechanism as recited in claim 8 on appeal. Accordingly, we sustain the examiner's rejection of claim 8 on appeal.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 3 and 7 and 9 under 35 U.S.C. § 103 is reversed, and the decision of the examiner to reject claim 8 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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RICHARD B. LAZARUS)	
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APPLICATION NO. 08/912,585

APJ LAZARUS

APJ McQUADE

APJ STAAB

DECISION: **Affirmed-In-Part**

Prepared By:

DRAFT TYPED: 10 Jan 02

FINAL TYPED: